

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Tran N. Nguyen

Art Unit: 2834

In re:

Applicant: Markus HEIDRICH

Serial No.: 10/031,829

Filed: January 22, 2002

SIMULTANEOUS AMENDMENT

February 5, 2004

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This Amendment is submitted simultaneously with filing of the
above identified application.

In the parent application the Examiner applied against the claims the patent to Barbati.

In connection with the Examiner's rejection of the claims over the art, in particular over the patent to Barbati, applicant wishes to make the following remarks.

The patent to Barbati uses the word "co-molded"; however there are major differences between the present invention and the invention disclosed in the patent to Barbati. According to claim 1 of the patent to Barbati the pole shoes 10 have radial teeth 11 on which there is co-molded an electrically insulating coating 12. This means that either the patent to Barbati teaches to co-mold the coating 12 on both the shoe 10 and the tooth 11, or this reference teaches to co-mold the coating 12 on the tooth 11.

In contrast, in accordance with the present invention, in the inventive stator the coil body 28 is integrally extruded only on the pole shoe 15.

In accordance with the applicant's invention the component which consists of the coil 11 or the coil body 28 and the pole shoe 15 is slid

onto the pole tooth 7. With the teaching of the patent to Barbati, this would not be possible, since Barbati teaches an integral component formed by the pole shoe 10 and the pole tooth 11. In contrast, in accordance with the applicant's invention, the pole shoe 15 and the pole tooth 7 are separate components that are joined together.

It is believed that the use of the term "co-mold" in the patent to Barbati is a mistake. As shown in Figures 4-7, Barbati teaches to manufacture a plastic ring. This ring does not seem to be integrally manufactured with the pole shoes 10. As shown in Figure 3, the pole shoes 10 that comprise pole teeth 11 are assembled with the plastic ring that must have been produced before (as shown in Figures 4 and 7).

In the applicant's invention since the coil body 20 is integrally manufactured with the pole shoe and the coil is wound on the coil body and slid onto the starter pole tooth by means of the pole shoe, the coil body 28 with the pole shoe 15 both have to be slid onto the pole tooth 7.

The patent to Barbati does not disclose these features and therefore this reference can not anticipate the present invention as defined in claim 1.

As was clearly stated in Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it is stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the reference does not provide this and does not teach each and every element of the present invention arranged as in claim 1.

In Row v. Dror, 42 USPQ 2d 1550, 1553 (Fed. Cir. 1997) it was stated:

“A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. .. Absence from the reference of any claimed element negates anticipation.”

It is therefore believed to be clear that the present invention as defined in claim 1 can not be anticipated by the patent to Barbarti.

As for the combination of the references, the other references do not provide any hint or suggestion that the features of the amended claim 1 are disclosed in these references or can not be derived from them as a matter of obviousness. Therefore, any combination of the references would also not lead to the applicant's invention as defined in claim 1.

The present invention also can not be derived from the prior art as a matter of obviousness, since the prior art, in order to arrive at the present invention, must be fundamentally modified. However, It is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structural to one which prior art references do not suggest.

Definitely, the prior art does not contain any suggestion for such modifications.

The present invention also provides for the highly advantageous results. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

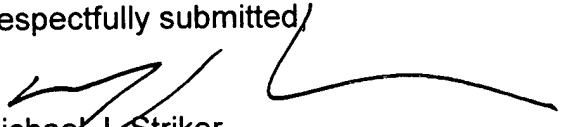
Consideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

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then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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